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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/770,125	02/03/2004	Kyo Nakayama	MRI-025	7257
20374	7590	11/18/2005	EXAMINER	
KUBOVCIK & KUBOVCIK SUITE 710 900 17TH STREET NW WASHINGTON, DC 20006			WALCZAK, DAVID J	
			ART UNIT	PAPER NUMBER
			3751	

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/770,125	NAKAYAMA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	David J. Walczak	3751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 11 October 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 1-4 and 11-20 is/are rejected.  
 7) Claim(s) 5-10 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>6/10/04</u> .	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Election***

Applicant's election without traverse of Species I in the reply filed on 10/11/05 is acknowledged. Claims 1-20 are readable thereon and, accordingly, will be examined herein.

***Claim Objections***

Claims 7 and 10 are objected to because of the following informalities: On line 2 of these claims, "be" should be --is--. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 11-13 and 15-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Jolly et al. (hereinafter Jolly). In regard to claims 1 and 2, Jolly discloses a writing implement having a grip structure in which a grip is provided on a grip portion of a barrel wherein the grip structure includes a gel substance (see column 3, line 63) capable of preserving its own shape (when the gel is subjected to a magnetic force, the gel "preserves its own shape", see column 6, lines 41-46). In regard to claim 3, an outer coat 40 covers the grip portion wherein the gel is located in the cavity 35 between the

outer coat and the barrel. In regard to claim 4, a centering member (the thickened portion of barrel 36 directly below flange 36a) is positioned between the outer coat and the barrel for positioning the outer coat coaxially with the barrel. In regard to claim 11, viewing Figure 2, a collar portion (not numbered) projects outwardly from the barrel at a front end of the grip portion and the outer coat includes an annular convex portion directed inwardly to contact the collar portion. In regard to claim 12, the above defined centering member projects outwardly from the barrel at the rear end of the grip portion to contact the outer coat (at 40b). In regard to claim 13, as discussed supra, Jolly discloses the claimed structure. In regard to claim 15, Jolly discloses a writing point 16 and a ferrule 37,46 at the front of the barrel wherein a front portion of the outer coat is in contact with the ferrule and an outside diameter of the coat (at 40a) is smaller than an outside diameter of the ferrule at the contact point. In regard to claims 16 and 17, Jolly discloses a front barrel 36 and a rear barrel 41 wherein the rear barrel "covers" the contact point between the outer coat and centering member (when the writing implement is positioned with the tip directed downwardly, the rear barrel "covers" the contact point).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jolly. Although the Jolly reference does not disclose that the barrel, outer coat and gel are all transparent, the Examiner takes official notice that writing implements are often designed from transparent materials in order to enable a user to view the inner workings of the implement. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the barrel, outer coat and gel (as well as other components) of the Jolly device from a transparent material in order to enable a user to view the inner workings of the device.

#### ***Allowable Subject Matter***

Claims 5-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Ferrara, Jr. reference is cited for disclosing another grip for a writing implement wherein gel is employed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Walczak whose telephone number is 571-272-4895. The examiner can normally be reached on Mon-Thurs, 6:30- 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on 571-272-4835. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Walczak  
Primary Examiner  
Art Unit 3751

DJW  
11/16/05